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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,380	11/24/2000	Krister Hansson	TTP 31349	3719

7590 02/22/2005
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EXAMINER

GARLAND, STEVEN R

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/718,380	HANSSON ET AL.	
	Examiner	Art Unit	
	Steven R Garland	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/3/05 and 12/1/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 27-29, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/1/04 has been entered.
2. The declarations filed on 12/01/04 by Krister Hansson, Diane Tate, and Ingvar Sylegard under 37 CFR 1.131 have been considered but are ineffective to overcome the Chen 6,617,009 reference.

In general the following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) **> If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.< .

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection.

In regards to the declaration of Krister Hansson: the declaration is defective since it is by only one of the inventors and all the inventors must sign the declaration unless the conditions noted above in paragraph (B) are met. Further the declaration does not explain what it is being relied on to show.

In regards to the declaration by Diane Tate, for the assignee, the declaration is defective since the requirements for accepting a declaration by the

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assignee have not been shown to have been met. Note paragraph (D) above and 37 CFR 1.131. Further the declaration does not explain what it is being relied on to show.

In regards to the declaration of Ingvar Sylegard, the declaration is not by the inventor of the claimed subject matter or a party qualified under 37 CFR 1.42, 1.43, or 1.47 to make a declaration under 37 CFR 1.131. The declaration is therefore defective, since it is not made by a qualified party.

Also note MPEP 715.07 which states the following:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

Applicant has also has not explained what the declarations are being relied on to show. Any declaration being filled under 37 CFR 1.131 must comply with the requirements of 37 CFR 1.131. Also see MPEP sections 715.04, 715.07-715.07(c).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits

pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33.

The declaration by Ingvar Sylegard, also refers to a verified translation of the Swedish priority document which is an attachment to the declaration. The Swedish priority document however has a later date than the effective filing date of the Chen reference and is ineffective to overcome the Chen reference.

In response to applicant's comments, the reference to Chen et al. remains a proper reference in view of the ineffective declarations. Secondly until conception is established diligence is not at issue. Thirdly while Ingvar Sylegard has submitted a declaration, this declaration by itself it is insufficient to overcome the Chen et al. reference, since it is not one of the parties recognized under 37 CFR 1.131. It however might provide factual support for a proper declaration under 37 CFR 1.131.

It is suggested that if a verified translation of the priority document is being relied upon to support a 37 CFR 1.131 declaration that support for specific claim limitations in the translation be pointed out in the declaration.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-21, 27- 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Chen et al. 6,617,009.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

In regards to the printing, Mckee in col. 3, lines 59-60 does teach cutting tiles with a device similar to an ink jet printer, but in lines 60-63, Mckee teaches dye or glaze

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using such a system and provides other details in col. 15, lines 21-47, but simply fails to use the term printing. Also McKee teaches printing patterns on tiles in col. 1, lines 41-63.

McKee while teaching the use of printed tiles does not specifically use them or go into details about segmentation of the border region since this is a function of the decor being implemented.

It would have been obvious to one of ordinary skill in the art to modify McKee to allow the use of printed tiles for ease in manufacture.

Further it would have been obvious to one of ordinary skill in the art to modify McKee to allow segmentation of the border region and choice in decor being applied to the border region so that the selected artistic rendering could be accomplished.

McKee however does not teach the use of tongue and grooved elements or providing a protective layer by spray coating, curtain coating etc. McKee does teach the use of a protective coating but requires that coating element be required to withstand high temperatures.

Chen et al. teaches the use of tongue and grooved elements which inherently require the use of a "intermediate distance " to form a tongue or groove and applying a protective coating without the use of high temperatures. See col. 3, lines 1-8; col. 6, lines 7-22; and col. 11, lines 41-67.

It would have been obvious to one of ordinary skill in the art to modify McKee in view of Chen and use tongue and grooved elements for ease in keeping the surface flat

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and also to provide a protective coating by coating a plastic tile if the tile can not stand high temperatures to prevent damage to the surface.

In response to applicant's arguments, as noted above the declaration under 37 CFR 1.131 is ineffective to overcome the Chen reference. Further Mckee teaches that the overall design can be pictorial, abstract, derived from a photos, etc. See col. 2, line 65 to col. 3, line 4; col. 5, lines 10-46; col. 8, lines 1-45.\

6. Claims 1-21,27-29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Finkell, Jr. 5,797,237 alone or in further view of Newton et al. 6,504,559 .

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

In regards to the printing, Mckee in col. 3, lines 59-60 does teach cutting tiles with a device similar to an ink jet printer, but in lines 60-63, Mckee teaches dye or glaze using such a system and provides other details in col. 15, lines 21-47, but simply fails to use the term printing. Also Mckee teaches printing patterns on tiles in col. 1, lines 41-63.

Mckee however does not teach the use of tongue and grooved elements.

Finkell, Jr. teaches the use of tongue and grooved flooring elements, and artistic renderings on flooring. See the abstract and col. 1, lines 5-17. Finkell also teaches that the system allows ease in installation (col. 2, lines 1-3) and the use of various types of substrates and manufacturing methods and the use of a protective wear coating such as wax. (col. 6, lines 19-46) and also note claim 9 which teaches an aluminum oxide coating (wear coating).

It would have been obvious to one of ordinary skill in the art to modify Mckee in view of Finkell and use tongue and grooved elements for ease in installation in view of Finkell's express teaching.

Mckee while teaching the use of printed tiles does not specifically use them or go into details about segmentation of the border region since this is a function of the decor being implemented.

It would have been obvious to one of ordinary skill in the art to modify Mckee to allow segmentation of the border region and choice in decor being applied to the border region so that the selected artistic rendering could be accomplished.

Newton et al. teaches printing a pattern on a tile. See col. 2, lines 44-52; col. 3, lines 7-20; col. 4, lines 19-27; and col. 7, lines 55-62.

It would have been obvious to one of ordinary skill in the art to modify Mckee and Finkell to allow the use printed tiles for ease in manufacturing or in further view of the express teaching of Newton and allow the use printed tiles for ease in manufacture and also allow the production of small production runs.

Mckee does teach the use of a protective coating but requires that coating element be required to withstand high temperatures however Finkell teaches the use of a protective wear coating in the form of wax (col. 6, lines 19-60).

It would have been obvious to one of ordinary skill in the art to modify Mckee and Finkell/Newton and apply a protective wear coating such as wax by a roller or spraying to protect the artistic design from wet foot traffic.

Further it would have been obvious to one of ordinary skill in the art to modify Mckee, Finkell, Newton and not perform printing until the substrate has the tongue and groove formed to prevent destruction of printed data and reduce ink use.


7. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 571-272-3741. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached at (571)272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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